
In the United States
Circuit Court of Appeals
For the Ninth Circuit.

Wilson-Western Sporting Goods Co.,
a corporation,

Appellant and Cross-Appellee,

vs.

George E. Barnhart,

Cross-Appellant and Appellee.

PETITION FOR REHEARING.

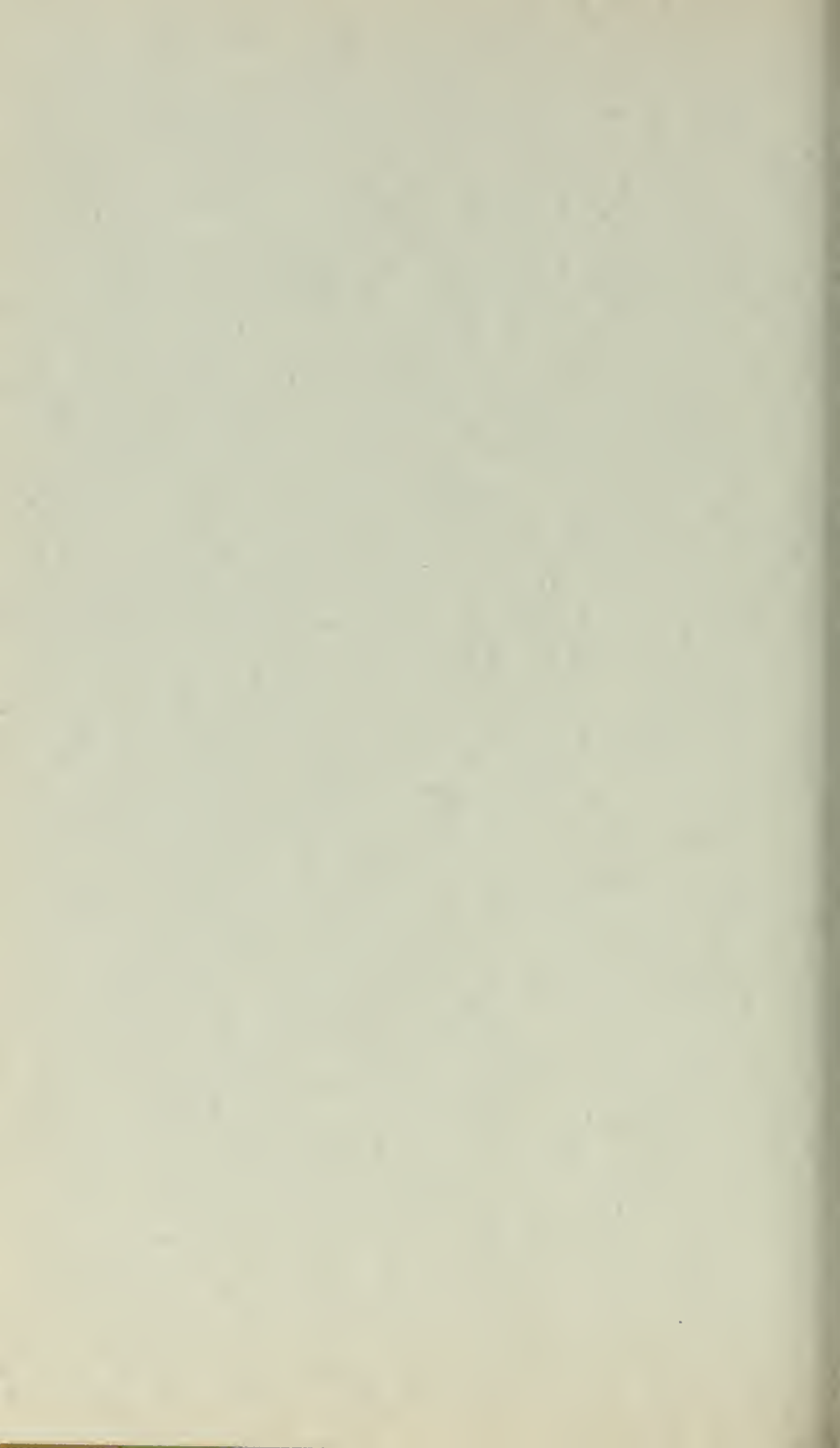
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PAUL P. O'BRIEN,



No. 7807.

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Wilson-Western Sporting Goods Co., a corporation, <i>Appellant and Cross-Appellee,</i> <i>vs.</i> George E. Barnhart, <i>Cross-Appellant and Appellee.</i>

PETITION FOR REHEARING.

To the Honorable Judges of the United States Circuit
Court of Appeals:

Now comes the appellee, George E. Barnhart, by his attorney and moves this Honorable Court for a rehearing herein, first, on the ground that this Court, in conflict with its own prior decisions of *Smith v. Howland*, 11 F. (2d) pp. 9-13, *Stoody v. Mills Alloys*, 67 F. (2d) 807, and the Supreme Court cases of *Furrer v. Ferris*, 145 U. S. p. 133, 36 L. Ed. pp. 649-651, and *Davis v. Schwartz*, 155 U. S. 631, 39 L. Ed. 289-293, found that with respect to the Master's Findings that "the report of the Master is entitled to little if any weight in this court," and

Secondly, on the ground that this Court erroneously found claims 11 and 12 of the first Barnhart patent and

claim 10 of the second Barnhart patent void as lacking invention.

With respect to the first point, mentioned above, this Court quoted at length from the case of *Kimberly v. Arms*, 129 U. S. 512, 523-524. In the instant case the Order of Reference [Tr. pp. 27-28] provided that the Master—

“take and hear the evidence offered by the respective parties and to make his conclusions as to the facts in issue and recommend the judgment to be entered thereon; the said Special Master DAVID B. HEAD is authorized and empowered to do all things and to make such orders as may be required to accomplish a full hearing on all matters of fact and law in issue in this cause, reserving to the Court the full right and power to review and determine all questions of fact and law upon exceptions to the report of said Special Master by the respective parties, as fully and completely had this reference not been made and as though this cause had been tried before the Court; the objection of counsel for the defendant to the making of this order referring the cause to the Master is hereby noted, and an exception is allowed in favor of the defendant.”

After the Master filed his report, both plaintiff and defendant filed exceptions to the Master's report. [Tr. pp. 160-162.] It is true that the Master's report by stipulation was adopted as Findings of Fact and Conclusions of Law, but this was done only after the Court heard the case upon the exceptions to the Master's report and after the Court had considered the pleadings and proof and argument by both parties as appears in the preamble to the decree on page 164 of the transcript. In other words

the District Court in this case, as pointed out on page 4, of appellant's brief, overruled the exceptions taken by both parties and confirmed the report of the Special Master.

In the quotation from the *Kimberly v. Arms* case, found in the opinion of this Court, is the following:

"It is not within the general province of a master to pass upon all the issues in an equity case, nor is it competent for the court to refer the entire decision of a case to him without the consent of the parties."

In that case the order of reference stated in part:

"Richard D. Harrison be and is hereby appointed a special master herein to hear the evidence and *decide all the issues* between the parties," etc. (Italics ours.)

In the instant case, the order provided that the Master "take and hear the evidence offered by the respective parties and make his conclusion as to the facts in issue and recommend the judgment to be entered thereon" * * * "reserving to the Court the full right and power to review and determine all questions of fact and law upon exceptions to the report of said Special Master by the respective parties, as fully and completely had this reference not been made and as though this cause had been tried before the Court;"

Under the terms of the reference, just quoted, the Court did not "of its own motion, or upon the request of one party abdicate its duty to determine by its own judgment the controversy presented," as stated in the *Kimberly v. Arms* case, but on the contrary specifically ordered and reserved to the District Court the full right and power to review and determine all questions of fact and law upon exceptions to the Master's report. This Court, in the

case of *Smith v. Howland*, 11 F. (2d) pp. 9-13, in an opinion written by Hunt, Circuit Judge, stated:

“(2) To enter upon an extended statement of the evidence upon the merits would greatly lengthen this opinion, and is unnecessary. The findings of fact, having been approved by the District Court after a review of the evidence, are to be taken as presumptively correct, and unless obvious error has intervened in applying some principle of law or some important mistake has occurred in weighing the evidence, the decree will not be reversed. *Furrer v. Ferris*, 12 S. Ct. 821, 145 U. S. 132, 36 L. Ed. 649; *Road Imp. Dist. v. Wilkerson* (C. C. A.) 5 F. (2d) 416.”

The Supreme Court in the case of *Furrer v. Ferris*, 145 U. S. p. 133, 36 L. Ed. pp. 649-651, stated:

“Upon the testimony, both the Master and the Circuit Court found that there was no negligence, and while such determination is not conclusive, it is very persuasive in this Court. In *Crawford v. Neal*, 144 U. S. 585 (36:552), it was said:

“The cause was referred to a Master to take testimony therein, “and to report to this court his findings of fact and his conclusions of law thereon.” This he did, and the court, after a review of the evidence, concurred in his finding and conclusions. Clearly, then, they are to be taken as presumptively correct, and unless some obvious error has intervened in the application of the law, or some serious or important mistake has been made in the consideration of the evidence, the decree should be permitted to stand. *Tilghman v. Proctor*, 125 U. S. 136 (31:664); *Kimberly v. Arms*, 129 U. S. 512 (32:764); *Evans v. State Bank*, 141 U. S. 107 (35:654).’ ”

In the case of *Stoody Co. v. Mills Alloys*, 67 F. (2d) 807 (C. C. A. 9th Circuit), the wording of the Order of Reference was in substance the same as in the instant case, the Court reserving "the full right and power to review and determine all questions of fact and law," and while in that case both sides agreed to the reference it was not an agreement to permit the Master to dispose of the case without a review by the Court. In that case this Court then inquired into the degree of weight to be given to the Master's Findings of Fact concurred in and approved by the District Court, in a general reference made "as above set forth", and in arriving at its conclusions followed the law in *Smith v. Howland*, *supra*.

In the case of *Davis v. Schwartz*, 155 U. S. 631, 39 L. Ed. 289-293, the Court stated as follows:

"1. As the case was referred by the court to a master to report, not the evidence merely, but the facts of the case, and his conclusions of law thereon, we think that his finding, so far as it involves questions of fact, is attended by a presumption of correctness similar to that in the case of a finding by a referee, the special verdict of a jury, the findings of a circuit court in a case tried by the court under Revised Statutes, 649, or in an admiralty cause appealed to this court."

As stated in the *Stoody Co. v. Mills Alloys* case, referred to above, "the matter of invention is one of fact", and it is our contention that the Master having found invention, and after argument on exceptions to the Master's report, the District Court confirmed that report, that while this finding is not conclusive it should have great weight before this Court, and not be set aside unless clearly erroneous.

It is further our contention that it was not intended by the Supreme Court in the *Kimberly v. Arms* case, cited in this Court's opinion, to pronounce a rule substantially nullifying the Master's report or as stated by this Court in its opinion, that

“Under such circumstances, the report of the Master is entitled to little if any weight in this Court.”

Had the reference, in this case, been to the Master with full power to “decide all the issues” as in the *Kimberly v. Arms* case, the objection by one of the parties to such reference would have the effect quoted by this Court. But if where, as in this case, the Court reserved full power to review and where the case was fully argued on exceptions to the Master's report and the Court found the same as the Master, the same ruling is applied, then the objection of one party to a reference simply means that by such objection the work of the Master in his consideration of the evidence taken before him and the writing of his report is of little or no value.

On the second proposition, it is appellee's contention that the Master found correctly on the question of invention and that as such finding was adopted by the District Court, the findings, by both the Master and District Court, should have great weight on the question of invention before this Court.

On this proposition, to-wit, that the structure in issue involved invention, it is our contention that the Court has misconstrued the teachings of the patents in the art and their application on the question of invention to the patents in suit.

In the *Stoody Co. v. Mills Alloys* case, above referred to, this Court found that “the matter of invention is one of fact”.

Taking up first the patent to Heller and the reissue of that patent, this Court states, that the—

“mobility between socket and shaft or rod is not new. It is disclosed in the patents to Heller”.

A reference to these patents, Book of Exhibits, pp. 57-61, disclose that there is no contact between the shaft and the head of the club other than through a rubber sleeve which, as stated in the Heller patents, is the full length of the bore, in other words, the shaft is cushioned *throughout its length* and extending entirely through the head of the club, which is a different problem from that of the Barnhart patents where there is a metal to metal contact between the hosel and the shaft. The “mobility between socket and shaft” in the Barnhart patent, in so far as the claims in issue are involved, relates only to “the portion of the shaft within the outer end of the socket being movable relative to the latter” as stated in claim 10, in the second Barnhart patent and “the portion of the shaft near the outer end of said socket being freely movable within and relative to and about the outer end portion of said socket” as stated in claim 11 of the first Barnhart patent. From this it will appear that there is nothing in the Heller patent that teaches the solving of Barnhart’s problem and must have been so considered by the Patent Office; which is likewise true of the Robertson patent.

With reference to the Robertson patent, referred to by this Court, that patent, even granted that it may be considered analogous art, relates to a *handle* of a fishing rod.

Barnhart's inventions are directed to the *head* of the club and not to the handle portion where the problem is again entirely different from that of Robertson. To understand this merely consider casting with a fishing rod held by the *handle* and then the striking of a golf ball by the *head* of a golf club thirty inches from the handle of the club. This Court has quoted from the Robertson patent relating to the elasticity of the rod and consequently the bending of the rod from the tip of the rod to the "extreme end of the butt" which has to do particularly with the hollow handle of the Robertson rod *which permits the rod to bend within the handle*. Attention is called to the fact that the claims in issue do not refer to any structure relating to this feature which among others is disclosed in the Barnhart patent.

In the Lard patent referred to by this court the shaft fits the "tubular socket member 4" throughout the full length of the socket member, entirely unlike Barnhart.

The Barnhart patents issued in 1927, two years before the adoption of the Barnhart invention by the defendant. We believe that the Court, on this question of invention, should also taken into consideration the admission of the defendant in its catalogue as appears on page 17, of the Book of Exhibits, where it states "that these improvements are unique" and "this invention is so ingeniously worked out", etc., and the further fact that it was only after Barnhart published his invention that the defendant, the manufacturer, saw the advantages of such a construction and adopted it.

In our brief, before this Court on appeal, at pages 13 and 14, we have quoted from leading cases that the adoption and use by the defendant of the invention in issue

is sufficient to overcome attacks which may be made by defendant on the patentability of the invention of the patent. In this case there is the presumption of validity which attaches to the issuance of the patent by the Patent Office followed by the finding of the Master after hearing the evidence and argument, and the confirmance of the Master's finding by the Court after argument on exceptions, filed by defendant excepting particularly to the Master's finding that the Barnhart patents were "good and valid in law". [Tr. p. 160.]

It is noted that the Court has deemed the means of distributing the strain at the junction of shaft and hosel as "obvious" but the record, in this case, shows that it was not "obvious" until Barnhart made his invention, as for instance, the Robertson patent, issued in 1878, given the credit ascribed to it by this Court, did not affect golf club construction until the Barnhart patents in 1927. In this connection the Supreme Court, in the case of *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 220 U. S. 435, 55 L. Ed. 531, stated as follows:

"Many things, and the patent law abounds in illustrations, seem obvious after they have been done, and, 'in the light of the accomplished result,' it is often a matter of wonder how they so long 'eluded the search of the discoverer and set at defiance the speculations of inventive genius.' *Pearl v. Ocean Mills*, 2 Bann. & Ard. 469, Fed. Cas. No. 10,876, 11 Off. Gaz. 2. *Knowledge after the event is always easy*, and problems once solved present no difficulties, indeed, may be represented as never having had any, and expert witnesses may be brought forward to show that the new thing which seemed to have eluded the search of the world was always ready at hand and easy to be seen by a merely skillful attention. But

the law has other tests of the invention than subtle conjectures of what might have been seen and yet was not. It regards a change as evidence of novelty, the acceptance and utility of change as a further evidence, even as demonstration. And it recognizes degrees of change, dividing inventions into primary and secondary, and as they are, one or the other, gives a proportionate dominion to its patent grant." (Italics ours.)

In conclusion, it is submitted that this Court should give substantial weight to the findings of fact by the Master, concurred in by the District Court and not set such findings aside unless clearly erroneous; and that the patents of the prior art referred to and discussed by this Court in its opinion do not deprive the claims in issue, of the Barnhart patent, of invention.

Respectfully submitted,

GEORGE E. BARNHART,

By FRANK L. A. GRAHAM,

His Attorney.

I hereby certify that the above petition is well grounded in law and proper to be filed and is not interposed for the purpose of delay.

FRANK L. A. GRAHAM,

Attorney for Appellee.

Los Angeles, California, February 3, 1936.

Copies of this petition for rehearing have been mailed to Counsel for appellant.